



DEC 11 2003

PTO/SB/21 (08-03)

Approved for use through 08/30/2003. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	10/091,372
Filing Date	March 4, 2002
First Named Inventor	Eric M. Ferreira
Art Unit	1755
Examiner Name	Jam s W. Pasterczyk
Mail Stop	Attorney Docket Number 1950-0001

RECEIVED  
DEC 15 2003  
TC 1700

### ENCLOSURES (Check all that apply)

- No fee due
  - Fee Transmittal
- Fee(s) due
  - Fee Transmittal
  - Check for \$\*
- Charge any underpayment or credit any overpayment to Deposit Account No. 18-0580
- Return postcard
- Amendment/Reply
  - After Final
  - Affidavits/declaration(s)
  - Extension of Time Request
  - Express Abandonment Request
  - Information Disclosure Statement & Form(s) PTO-1449
  - Copy(ies) of cited reference(s)
  - Certified Copy of Priority Document(s)
  - Response to Missing Parts / Incomplete Application
  - Response to Missing Parts under 37 CFR 1.52 or 1.53

- Drawing(s)
- Licensing-related Papers
- Petition
- Petition to Convert to a Provisional Application
- Power of Attorney, Revocation, Change of Correspondence Address
- Terminal Disclaimer
- Request for Refund
- CD, Number of CD(s):

- After Allowance Communication to a Technology Center (TC)
- Appeal Communication to Board of Appeals and Interferences
- Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
- Proprietary Information
- Status Letter
- Other Enclosure(s) (please identify below):

#### Remarks:

The Commissioner is hereby authorized to charge any additional or underpayment of fee(s) to Deposit Account No. 18-0580.

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual Name (print/type)	Shelley P. Eberle, Reg. No. 31,411 Reed & Eberle LLP	Telephone	(650) 330-0900
Signature	<i>Shelley P. Eberle</i>	Date	December 9, 2003

### CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Name (print/type)	Joe Clark		
Signature	<i>JCL</i>	Date	December 9, 2003

DEC 11 2003

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**FEE TRANSMITTAL  
for FY 2004**

Effective 10/01/03. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT \$0.00

Complete if Known

Application Number	10/091,372	RECEIVED
Filing Date	March 4, 2002	DEC 15 2003
First Named Inventor	Eric M. Ferreira	
Examiner Name	James W. Pasterczyk	
Group Art Unit	1755	TC 1700
Attorney Docket No.	1950-0001	

**METHOD OF PAYMENT (check all that apply)** Check  Credit card  Money Order  Other  None Deposit Account:

Deposit Account No.	
Deposit Account Name	

The Commissioner is authorized to: (check all that apply)

- Charge fee(s) indicated below  Charge any underpayment or credit any overpayments
- Charge any additional fee(s) during the pendency of this application
- Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity	Small Entity	Fee Description	Fee Paid
Fee Code (\$)	Fee Code (\$)		
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
<b>SUBTOTAL (1)</b>		\$	

**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

Total Claims	Independent Claims	Multiple Dependent	Extra Claims	Fee from below	Fee Paid
42	4		0	x	=
- 42** =	- 4** =		0	x	=
					=

Large Entity	Small Entity	Fee Description
Fee Code (\$)	Fee Code (\$)	
1202 18	2202 9	Claim in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent
<b>SUBTOTAL (2)</b>		\$0.00

\*\*or number previously paid, if greater; For Reissues, see above

**FEE CALCULATION (continued)**

3. ADDITIONAL FEES		Large Entity	Small Entity	Fee Description	Fee Paid
Fee Code (\$)	Fee Code (\$)				
1051 130	2051 65	Surcharge - late filing fee or oath			
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet			
1053 130	1053 130	Non-English specification			
1812 2,520	1812 2,520	For filing a request for ex parte reexamination			
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action			
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action			
1251 110	2251 55	Extension for reply within first month			
1252 420	2252 210	Extension for reply within second month			
1253 950	2253 475	Extension for reply within third month			
1254 1,480	2254 740	Extension for reply within fourth month			
1255 2,010	2255 1,005	Extension for reply within fifth month			
1401 330	2401 165	Notice of Appeal			
1402 330	2402 165	Filing a brief in support of an appeal			
1403 290	2403 145	Request for oral hearing			
1451 1,510	1451 1,510	Petition to institute a public use proceeding			
1452 110	2452 55	Petition to revive – unavoidable			
1453 1,330	2453 665	Petition to revive – unintentional			
1501 1,330	2501 665	Utility issue fee (or reissue)			
1502 480	2502 240	Design issue fee			
1503 640	2503 320	Plant issue fee			
1460 130	1460 130	Petitions to the Commissioner			
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)			
1806 180	1806 180	Submission of Information Disclosure Stmt			
8021 40	8021 40	Recording each patent assignment per property (times number of properties)			
1809 770	2809 385	Filing a submission after final rejection (37 CFR § 1.129(a))			
1810 770	2810 385	For each additional invention to be examined (37 CFR § 1.129(b))			
1801 770	2801 385	Request for Continued Examination (RCE)			
1802 900	1802 900	Request for expedited examination of a design application			
Other fee (specify)		\$		<b>SUBTOTAL (3)</b>	

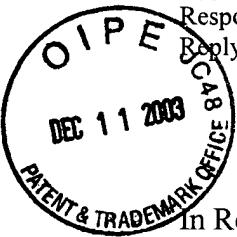
\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

\$

**SUBMITTED BY**

Name (Print/Type)	Shelley P. Eberle	Registration No. (Attorney/Agent)	31,411	Telephone	Complete (if applicable)
Signature	<i>Shelley P. Eberle</i>			Date	December 9, 2003



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**RECEIVED**

**DEC 15 2003**

**TC 1700**

In Re Application of:

Eric M. FERREIRA et al.

Confirmation No.: 7247

Serial No.: 10/091,372

Group Art Unit: 1755

Filing Date: March 4, 2002

Examiner: James W. PASTERCZYK

Title: METHODS AND COMPOSITIONS FOR ENANTIOSELECTIVE OXIDATION REACTIONS

**RESPONSE TO REQUIREMENT FOR RESTRICTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is in response to the Requirement for Restriction mailed November 14, 2003.

**THE RESTRICTION REQUIREMENT**

The Examiner has required restriction between two groups of claims:

- (I) claims 1-24, drawn to a method of catalyzing an enantioselective oxidation reaction of an organic compound; and
- (II) claims 25-42, drawn to catalysts.

In response, applicants elect Group 1, claims 1-24, without traverse. Applicants expressly reserve their right under 35 USC § 121 to file a divisional application directed to the non-elected subject matter during the pendency of this application.

**THE REQUIREMENT FOR AN ELECTION OF SPECIES**

The Examiner has also indicated that the claims are generic to a plurality of patentably distinct species comprising various substrates and products made using the claimed process. In making the present restriction requirement, the Examiner has simply stated that there are a "plurality" of patentably distinct species comprising various substrates and products made using the claimed process. This treatment of the claims is inconsistent with the guidance given Examiners in the Manual of Patent Examining Procedure, where it is stated that the "best way to

most clearly and precisely indicate...how an application should be restricted" is to identify each separate subject and then group each claim with the subject. M.P.E.P. Section 814, part B. That section of the M.P.E.P. goes on to state that "[t]he separate inventions should be identified by a grouping of the claims with a short description of the total extent of the invention claimed in each group...." While this discussion pertains to restriction practice, at a minimum, the Examiner should identify what is considered to be a "species."

In the present case, the restricted subject matter has not been presented with an identification of separate species, as is normally done, and therefore the Examiner has not provided any guidance as to what species are to be elected.

Claim 1 is directed to a method of catalyzing an enantioselective oxidation reaction of an organic compound comprising contacting the organic compound with an oxidizing agent, and a catalyst comprising a metal composition and a chiral ligand. Absent any guidance from the Examiner, it would appear that a possible species could be the different enantioselective oxidation reactions, organic compounds, oxidizing agents, and catalysts (metal composition and chiral ligand) encompassed by Claim 1. Therefore, the following election is an attempt to provide a complete response to the request for election under 35 U.S.C. § 121.

For the enantioselective oxidation reaction, Applicants elect the kinetic resolution of a racemic mixture. Claims 1-17 read on this reaction species. Claims 18-24 do not read on this species.

For the organic compound, Applicants elect alcohols. Claims 1-24 all read on this compound species.

For the oxidizing agent, Applicants elect molecular oxygen. Claims 1-24 all read on this agent species.

For the metal composition, Applicants elect palladium (II) complex, with a sub-species election of Pd(norbornadiene)Cl<sub>2</sub>, if needed. Claims 1-24 all read on this composition species.

For the chiral ligand, Applicants elect (-)-sparteine. Claims 1-24 all read on this ligand species.

It is to be understood that the aforementioned election of species is for the purpose of the Examiner's initial search and examination, and that upon allowance of a generic claim all remaining species encompassed by that claim should properly be examined.

Application No. 10/091,372  
Response To Requirement For Restriction dated December 9, 2003  
Reply to Office Communication of November 14, 2003

Atty Dkt No. 1950-0001

If the Examiner has any questions concerning this communication, or would like to discuss the application, the art, or other pertinent matters, they are welcome to contact the undersigned attorney at (650) 330-0900.

Respectfully submitted,

By: Shelley P. Eberle  
Shelley P. Eberle  
Registration No. 31,411

REED & EBERLE LLP  
800 Menlo Avenue, Suite 210  
Menlo Park, California 94025  
(650) 330-0900 Telephone  
(650) 330-0980 Facsimile

F:\Document\1950\0001\Restriction Requirement Response.DOC